



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,923	01/20/2004	Mehran Mokhtari	B-4801NP 621673-0	2158
65050	7590	11/14/2007		
HRL LABORATORIES, LLC 3011 MALIBU CANYON RD. MALIBU, CA 90265			EXAMINER PASCAL, LESLIE C	
			ART UNIT 2613	PAPER NUMBER
			MAIL DATE 11/14/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/761,923	Applicant(s) MOKHTARI ET AL.	
	Examiner Leslie Pascal	Art Unit 2613	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8-27-07.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-85 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-85 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2613

1. The reply filed on 8-27-07 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): The examiner made it clear in the species requirement that if the applicant elected species V there are two sets of subspecies. The examiner even gave an example of the proper way to respond IF the APPLICANT elected one of the subspecies. Yet the applicant has not elected subspecies. If the applicant elected species V, one of the transmitter subspecies A-C AND one of subspecies D-G. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

This application contains claims directed to the following patentably distinct species:

Species I) figure 17

Species II) figure 19

Species III) figure 20

Species IV) figure 21

Species V) figure 5

The species are independent or distinct because they have mutually exclusive characteristics.

It would appear that under species V there are two sets of subspecies. One is drawn toward the transmitter side and the other is drawn toward the

Art Unit: 2613

receiver side. If the applicant elects species V, he must also elect one subspecies from the transmitter subspecies and one subspecies from the receiver. (For example, "I elect species V drawn toward figure 5. I also elect subspecies A drawn toward figure 8 and subspecies D drawn toward figure 7. The claims that read on this election are..."). If the following subspecies are subspecies of species I-IV, the applicant should elect such subspecies, as well as, the species.

Transmitter subspecies:

- Subspecies A) figure 8
- Subspecies B) figure 9
- Subspecies C) figure 12

Receiver subspecies:

- Subspecies D) figure 7
- Subspecies E) figure 10
- Subspecies F) figure 11
- Subspecies G) figure 13

The subspecies are independent or distinct because they have mutually exclusive characteristics.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 23 and 45 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

2. In regard to the applicants remarks with regard to the restriction, the sections that the applicant quotes from the MPEP are drawn toward restriction requirements (not species requirements). With regard to the applicants' quotes from MPEP 808, the applicant should see MPEP 808.01 which clearly says that "Where there is no disclosure of a relationship between species (see MPEP §806.04(b)), they are independent inventions." Further, a PTO memo of 4-25-07 was sent to the examiners stating that "The current form paragraphs...

Art Unit: 2613

concerning election of species have caused confusion for some patent examiners and applicants. The current form paragraphs require an examiner to provide an explanation as to why the species are independent or distinct; the revised form paragraphs provide such explanation (i.e. "the mutually exclusive characteristics"). Using the revised form paragraphs, the examiner need only identify the species and identify the generic claim(s) (if present)." True species are mutually exclusive. The only reason that species should not be restricted is in the case that they are obvious over each other or so close in relationship that they do not require extra work by the examiner. It is clear from the numerous embodiments, claims, figures and areas that need to be searched that there is a serious burden on the examiner. Only someone that is not going to examine the case could say that such an unbelievable burden would not require an unbelievable amount of work to be done. If the applicant feels that the different embodiments should be worked on together, the applicant can state that they are obvious variants of each other. This is a valid reason for species to be examined together, but the examiner will use the applicants' statements that they are obvious in rejections.

The applicant argues that figures 19, 20 and 21 are specific embodiments of figure 5 (and it would appear that the applicant is arguing that they should not be separate embodiments from figure 5). This might be true if not for the presence of the subspecies that are included above. Because the subspecies are separate embodiments from figures 17, 19, 20 and 21. The examiner will restate

Art Unit: 2613

the restriction requirement in italics in a different way below (which means the same as the above restriction requirement).

This application contains claims directed to the following patentably distinct species:

Species I) figure 17

Species II) figure 19

Species III) figure 20

Species IV) figure 21

Species V) It would appear that under species V there are two sets of subspecies. One is drawn toward the transmitter side and the other is drawn toward the receiver side. If the applicant elects species V, he must also elect one of the following subspecies from the transmitter subspecies and one subspecies from the receiver. (For example, "I elect species V. I also elect subspecies A drawn toward figure 8 and subspecies D drawn toward figure 7. The claims that read on this election are..."). If the following subspecies are subspecies of species I-IV, the applicant should elect such subspecies, as well as, the species.

Transmitter subspecies:

Subspecies A) figure 8

Subspecies B) figure 9

Subspecies C) figure 12

Receiver subspecies:

Subspecies D) figure 7

Subspecies E) figure 10

Subspecies F) figure 11

Subspecies G) figure 13

The species are independent or distinct because they have mutually exclusive characteristics.

The subspecies are independent or distinct because they have mutually exclusive characteristics.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 23 and 45 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at

Art Unit: 2613

least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The applicants' arguments that the MERE 85 claims are all drawn to inventions in class 455 (the examiner works in class 398-optical communications), this argument is not persuasive. It is clear that the different embodiments would require using different art for the different embodiments which would require a great burden for 85 claims (unless they were obvious variants). Clearly only someone that was not going to have to examine the case would say such a statement.

The applicant does not argue that there are not subspecies, just that the applicant cannot figure out what the subspecies are or why they are restricted is not persuasive. They are mutually exclusive. The applicant must understand that figures 8, 9, 12, 17, 19, 20 and 21 have mutually exclusive transmitters. Just as figures 7, 10, 11, 13, 17, 19, 20 and 21 have mutually exclusive receivers. If the applicant has evidence that such are not mutually exclusive, he should give evidence.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie Pascal whose telephone number is 571-272-3032. The examiner can normally be reached on Monday- Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Chan can be reached on 571-272-3022. The fax

Art Unit: 2613

phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Leslie Pascal
Primary Examiner
Art Unit 2613